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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/313,048

05/17/99

CARSON

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103.009US1

021186

HM12/1004

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EXAMINER

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ART UNIT

PAPER NUMBER

1611

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DATE MAILED:

10/04/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/313,048**

Applicant(s)

**Carson et al.**

Examiner

**Ben Schroeder**

Group Art Unit

**1611**



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 3-7, and 10-17 is/are rejected.

☒ Claim(s) 2, 8, and 9 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### DETAILED ACTION

1. Claims 1-17 are pending.

#### *Specification*

2. This application does not contain an abstract of the disclosure as required by 37

CFR 1.72(b). An abstract on a separate sheet is required.

3. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 5, and 10-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is vague and indefinite in that it is not known what is meant by Z. There are two separate definitions for the variable Z. Additionally, if Z is an ester of an amino acid where is the point of attachment to A; the amino functionality or the side chain?

7. Claim 1 is also rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is vague and indefinite in that it is not known how NNO(OH) which is a possibility for the variable A is attached to the Z. Clarification is required.

8. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. Claim 3 recites the limitation "COOR" as the last word of claim 3. There is insufficient antecedent basis for this limitation in the claim. In claim 1, the claim to which claim 3 refers, R is not equivalent to  $R_3$ .

9. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 4 recites the limitation " $R_3$ " as the 7th word of claim 4. There is insufficient antecedent basis for this limitation in the claim. In claim 3, no reference is made to  $R_3$ .

10. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 6 recites the limitation "4-pyridyl" as the last word of claim 6. There is insufficient antecedent basis for this limitation in the claim. In claim 1, the claim to which 6 ultimately refers, nowhere is it indicated that Z can be 4-pyridyl.

11. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "ethoxycarbonylpropyl" as the last word of claim 7.   
CCOC(=O)CCC There is insufficient antecedent basis for this limitation in the claim. In claim 1, the claim to which 7 ultimately refers, nowhere is it indicated that  $R_1$  can be ethoxycarbonylpropyl.

12. Claims 11-14 are rejected under 35 USC 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The scope of the method claims 11-14 are not adequately enabled solely based on xanthine derivative as provided in the written description. Claims 11-14 are the method of treating any and all diseases and/or disorders associated with pathological inflammatory responses for any reason or for autoimmune diseases which is not remotely enabled. The scope of claims 11-14 include diseases and/or disorders not even known at this time which may be associated with inflammatory responses. While treatment of certain inflammatory responses have been linked with compounds of the class instantly claimed, the art does not recognize use of such compounds as broad based drugs for treating all disorders instantly embraced.

### *Claim Objections*

13. Claim 1 is objected to for the following informality: a comma appears to be missing after "SO<sub>2</sub>NH<sub>2</sub>" which is one of the possibilities for A.
14. Claims 2, 8, and 9 are objected to as being dependent upon a rejected base claim, but might be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ben Schroeder whose telephone number is (703) 306-5815. The examiner can normally be reached on Monday thru Friday from 8:30 AM to 5:00 PM.

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The fax phone number for this Group is (703) 308-4734 for "unofficial" purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

tbs



**Mukund J. Shah**

**Supervisory Patent Examiner**

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